
IN THE
United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT. 12

Francis M. Townsend, Milon J.
Trumble and Alfred J. Gutzler, do-
ing business under the firm name of
Trumble Gas Trap Co.,

Appellants,

vs.

Lorraine Corporation, a corporation,
Appellee.

APPELLANTS' REPLY BRIEF.

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APPELLANTS' REPLY BRIEF.

As stated in Appellant's Opening Brief, the only substantial question involved on this appeal is,—Has the lower court correctly interpreted and properly applied the decision of this Court (290 Fed. 54) in the previous case? Or did the lower court deny to the Trumble invention the scope adjudged to such invention by this Court? That this is the sole issue is emphasized in defendant-appellee's brief, page 4, where defendant-appellee says:

“If the expressed conclusions of the trial court are adopted and approved by Your Honors there will be nothing further in this suit to litigate,” etc.

As before pointed out, no subsequent testimony can materially change the case now before the Court on the

present record. These gas-traps or oil and gas separators are large enclosed devices. The precise manner of and results in operation must be determined by application of the principles of mechanics and physics incorporated in their mechanical construction. No one can see within one of these traps when it is in operation. Furthermore, it is not possible to determine from the exterior what is the internal construction.

Appellants submitted this case in the lower court upon the interpretation and decision of this Court in the previous case. Appellants herein rely upon such decision and such interpretation. Appellants submit that the two types or constructions of gas-traps last manufactured by the defendant-appellee and illustrated in the drawings, Fig's 5 and 6, Affidavit of William McGraw, and exemplified in physical Exhibits A-5 and A-6, comprise the combination of elements and instrumentalities organized in the relation and performing the precise functions adjudged by this Court in its former opinion to constitute the Trumble patented invention.

If upon the undisputed facts of this case, the lower court was wrong in its interpretation of the decision and adjudication of this Court in the former case, then the refusal of the injunction was reversible error. As said by this Court in *Sherman-Clay & Co. v. Searchlight Horn Co.*, 214 Fed. 99, after stating the general rule that the granting of a preliminary injunction in a suit for infringement of a patent rests within the sound discretion of the trial court and that under this rule the only question for this Appellate Court to determine is, "Had the court abused its discretion?" this Court says:

“But another general rule applicable to the present case is that, the validity of the patent having been sustained by a prior adjudication in an action at law, and the infringement being clear, the court has no discretion to refuse a temporary injunction pending a final hearing upon the issues involved in the case.”

Defendant-appellee does not deny that these two types or constructions are the latest products of defendant-appellee. In fact, it is admitted in appellee’s brief (p. 16): “True, the last two traps finally relied upon were made only shortly before the suit was filed.” Not only does this admission (adequately supported, without dispute, by the affidavits of the respective parties) dispose of all assertion of laches on the part of appellants, but it is the most cogent evidence of the commercial value of the Trumble invention. The step-by-step encroachment upon the particular combination of mechanical means and instrumentalities so adjudged by this Court to constitute the Trumble invention totally impeaches defendant-appellee’s words of belittlement. “The proof of the pudding is the chewing of the string.” Defendant-appellee now asserts that the Tonner No. 3 infringement was a mere unsuccessful abandoned experiment. Yet, although the other three constructions adjudged by this Court in its former opinion not to infringe were open to defendant-appellee’s free manufacture, and notwithstanding all of the praise that was given thereto by defendant-appellee at the prior hearing—lauding the commercial success and efficiency thereof—these stand in fact abandoned by defendant-appellee. Many other types and constructions have been tried, many of such other traps sold and put in use, but the Court has before it no explaining away by defendant-appellee of the commercial and mechanical necessities

which have clearly driven defendant-appellee to a re-adoption of the Trumble invention so clearly evidenced by the continued closer and closer approximation of the particular combination adjudged by this Court to have been Trumble's invention. Appellee seeks to secure the important advantages of Trumble's combination but retains some colorable change of form to disguise its piracy. It seeks to appropriate the substance but conceal this by mere change of form. That years of experience drive it to this necessity conclusively proves the merit of Trumble's inventive thought.

Without regard to the previous decision and decree being *res adjudicata* and binding upon defendant-appellee, as it is binding upon plaintiffs-appellants,—such prior adjudication is sufficient to entitle the appellants “to a preliminary injunction in a suit for infringement” “prior to a trial on the merits,” as stated in the rule of this Court's decision at page 61 of 182 Fed. Rep., in the case of *Kings County Raisin & Fruit Co. v. U. S. Consolidated S. R. Co.* The rule there applied is that the patent owner “must show three things: First, a clear title to the patent; second, its presumptive validity; and, third, threatened infringement by the defendant.” The Court then quotes from the opinion of Judge Hawley in *Norton v. Eagle Automatic Can Co.*, 57 Fed. 929:

“I understand the rule to be well settled that where the validity of a patent has been sustained as in this case, by prior adjudication in the same circuit, the only question open before the court on motion for a preliminary injunction, in a subsequent suit against other parties, is the question of infringement, and that the consideration of all other questions should be postponed until all of the testimony is taken in the

case and the case is presented upon final hearing. There is, perhaps, an exception to this rule—that in cases where new evidence is presented that is itself of such a conclusive character that, if it had been presented in the former case, it would probably have led to a different conclusion. The burden, however, of showing this, is upon the respondent.”

The present appeal presents an even narrower issue, to-wit: Did the lower court apply in this case the interpretation and scope of the Trumble invention adjudged thereto by this Court in the previous hearing?

As before pointed out, no subsequent testimony is available to change the record on the issue of infringement. Both parties seem in accord on this point.

Could defendant-appellee escape from the pleadings and the facts, and escape from the rule of *res adjudicata* (adjudicating between the parties hereto the validity and scope of the Trumble invention), the foregoing rule would still apply, and only that portion of the rule thus expressed by Judge Hawley, of “new evidence,” be open for determination, as to which the burden of proof would be upon the defendant-appellee. And there is no “new evidence;” solely an issue of infringement.

Before replying to the defendant-appellee’s contentions, we deem it a duty to point out to the Court the erroneous and highly misleading character of the statements contained in defendant-appellee’s brief; also some of the glaring inconsistencies, both of statements of alleged facts and of argument.

(1) A reading of defendant-appellee’s brief leaves it impossible to determine therefrom whether defendant-appellee intentionally asserts that there are only two gas-

traps that have been made by defendant-appellee which are charged to be an infringement. Such inference is plain. It is true that there are only two types of such traps, *i. e.*, the last two types or constructions so first produced by defendant-appellee within a month prior to the filing of the bill of complaint in this case and the making of the motion for temporary injunction. But defendant-appellee's brief says (p. 12):

“However, the point we are now endeavoring to present and emphasize is that *only two traps are charged to infringe*—a trifling basis for a cry of irreparable injury.”

(Italics are reproduced from
appellee's brief)

On page 13 this brief proceeds with the assertion that defendant was “putting out \$67,000.00 worth of traps per month.”

And just before this statement the brief again asserts:

“* * * plaintiffs finally admitted that only two traps made during a year could, under any theory, sustain the charge” (of infringement).

We submit these statements for this Court's careful notice and consideration. How many traps like Exhibits 5-A and 6-A, or Figs. 5 and 6 of the McGraw affidavit, have been made by defendant-appellee, or whether it has been manufacturing and installing such traps for a long time prior to the discovery thereof by plaintiffs-appellants within a month of the filing of the bill of complaint herein, —plaintiffs-appellants do not know. In plaintiffs' bill of complaint plaintiffs pray discovery of this number. The

fact remains undenied—yes, admitted—that this is the newest and latest type of construction of the defendant-appellee. No reason is given by defendant-appellee for the production of this type of trap. No denial is made by defendant-appellee that it is the type of trap that it intends hereafter to manufacture to the exclusion of all others.

It is anomalous that, with a successful business (as asserted) of \$67,000.00 per month in non-infringing and in licensed traps, the defendant-appellee should now find a compelling necessity for such a close approximation of the Trumble invention.

But defendant-appellee does not content itself with this assertion, for on page 14 occurs:

“Two traps out of many thousands—the utmost frankness and good faith in fully disclosing features of construction to plaintiffs. Surely, even assuming possible infringement, this insignificant trespass is too trifling to form the basis of a preliminary injunction.”

Notwithstanding all these words about defendant-appellee's tremendous business and its commercial success, the record in this case is totally silent on the part of defendant-appellee of any explanation whatsoever of why it has been driven to this re-adoption and re-infringement of the Trumble patent.

But it is not true that this case involves only two traps out of many thousands (Appellee's Brief, p. 14). Defendant-appellee has shown the intention to infringe; the intention to continue making and selling the two types of infringing trap. An injunction is to prohibit future trespass. The past will be taken care of in an accounting,

during which the evidence as to the number of such traps of these two types will be educed. Proof of one is all that is required or material for the injunctonal relief.

If, after many years of litigation and many years of commercial production and use, the defendant-appellee is shown to have reverted from the non-infringing constructions to a construction which in substance embodies the combination which this Court has determined is the Trumble invention, not only does such fact prove conclusively the commercial value of such Trumble invention, but it proves conclusively the necessity for, and the right of appellants to, injunctonal relief to prevent the appropriation of their adjudged patent property.

(2) *Laches*. In one breath (Br., bottom of p. 5) appellee asserts that the right to a preliminary injunction is barred because of "laches for over a year." The admission of appellee (Br., p. 16) that the two types of traps involved "were made only shortly before the suit was filed," fully answers this contention.

This is another example of appellee's inconsistencies.

(3) Appellee asserts, in large type (Br., p. 9), that, "Gas traps are large contrivances" "easily kept track of." But it is to be noted that nowhere in appellee's brief is there any attempt made to point out any evidence that the interior construction of these gas-traps can even be guessed at by viewing their exterior appearance. The fact is that the interior construction can only be determined by partially dismantling a trap and by a man crawling thereinto; that it is impossible to observe the operation; that the mode and principles of operation can only be determined by an analysis and consideration of the principles of me-

chanics employed and the laws of physics involved. The inferences plainly apparent throughout appellee's brief are calculated to mislead the Court to a conclusion that there is no difficulty in providing direct proof as to the actual operation of the infringing traps; that such operation is easily discernible. This is entirely inconsistent with appellee's contention that, "If the expressed conclusions of the trial court are adopted and approved" "there will be nothing further to litigate." "We can find no substantial issue of fact."

(4) Appellee asserts that a contempt proceeding would have been the proper procedure (Brief, p. 20) and that the filing of an original bill in a new suit constitutes an admission that the decree in the original suit is not *res adjudicata*. This contention is interwoven in appellee's brief with appellee's misrepresentation respecting the contempt proceedings which were instituted in the original suit and which were dismissed by Judge Bledsoe under the rule that the court will not in or by contempt proceedings adjudge a subsequent infringement unless it is a mere colorable evasion; that if the new infringement raises a substantial issue to be tried, then the Court will relegate the parties to either a new suit or to an application for a new and an extended injunction. This is the rule which has been established in the United States District Court for the Southern District of California. It is the rule which is generally applied in patent cases in the various circuits and districts. It is because of such rule that appellants brought this new suit so as to put this issue of infringement squarely before the Court, and not merely as an incidental issue in a contempt proceeding.

But, appellee misrepresents the facts respecting the contempt proceeding so terminated by Judge Bledsoe.

At the bottom of p. 18 of appellee's brief it is said:

“The defendant, however, was purged of the alleged contempt—and said Model 16 was found not an infringement of Judge Wolverton's decision, *broad as it was, before reversal by this court.*” (Italics reproduced from said brief.)

Judge Bledsoe's decision was not rendered before the decision of this Court on June 4, 1923 (290 Fed. 54). Whether appellee's misstatement is intentional, or through gross carelessness, can hardly be questioned. Appellee's brief, p. 3, gives the correct date of said decision of this Court,—June 4, 1923,—and following the above quotation from p. 18 of appellee's brief appellee refers to the Transcript of Record in this case, page 142, at which appears the contempt proceeding decision of Judge Bledsoe, at the close of which (p. 143) is definitely printed the date, “June 30, 1924,” as well as the endorsement of the clerk, “Filed Jun. 30, 1924.”

Judge Bledsoe's decision refers to “the injunction of Judge Wolverton.” This is technically an error. After the decision of this Court and pursuant to the mandate, a new interlocutory decree was signed by His Honor, Judge James, in accordance therewith. It was this decree and this injunction that was under issue. But how does appellee justify its point-blank assertion that Judge Bledsoe was giving the case Judge Wolverton's interpretation, “*broad as it was, before reversal by this court*”? Judge Bledsoe in his opinion [Tr. Rec. p. 142] says:

“Without indicating any opinion as to whether or not Model 16 is an infringement of the patent as con-

strued by the Circuit Court of Appeals, 290 Fed. 54, at page 59.”

It must be borne in mind by the Court that the facts of these former contempt proceedings were interjected into this suit by appellee. Doubtless this was for the purpose of influencing the Court as to what had been previously determined. Appellee makes the wrongful assertion that Judge Bledsoe determined that issue of infringement on the merits. Otherwise than as showing defendant-appellee's erroneous contention and misrepresentation of the character of such proceedings and of the fact that such proceeding did not decide the issue of infringement, such contempt proceedings are immaterial and irrelevant to the present suit.

(4) Appellee admits (Br., p. 24):

“If defendant Lorraine Corporation was in privity with Lorraine individually as regards the subject-matter of the prior suit, of course such corporate defendant would be bound by the perpetual injunction entered against Lorraine individually,” etc.

Appellants have pointed out (p. 4 of appellants' opening brief) the allegations of the bill of complaint and the admissions of defendant's answer that during the pendency of said original suit the defendant therein, David G. Lorraine, transferred his then existing business in the manufacture of crude petroleum and natural gas separators to the defendant Lorraine Corporation, which corporation thereupon became the successor of said David G. Lorraine in the manufacture of crude petroleum and natural gas separators, and continued to and participated in the defense of this suit. Although appellee seeks to avoid the

legal effect of these facts and admissions (Br., p. 19, *et seq.*), it admits:

“The Lorraine Corporation at the time of its organization (May 1, 1923) took over what is conceded in this proceeding to have been the largest organization for the manufacture and sale of gas traps in the world.” (p. 21.)

The decision of this Court in the original case was June 4, 1923, approximately seven weeks thereafter, but the original suit was not then concluded. Thereafter there was a new interlocutory decree entered pursuant to the mandate of this Court; there were contempt proceedings instituted in said Court involving the “Model 16” type of traps, after defendant-appellee had abandoned the manufacture and construction of the types involved in the original suit; there was thereafter filed a supplemental bill alleging infringement by such “Model 16” type of traps; there were accounting proceedings; and it was not until 1926 that the final decree was entered and filed. The entry of this final decree was participated in by the defendant-appellee, Lorraine Corporation. This is directly reflected by the agreement [Tr. Rec. p. 109]. During all this time, from May 1, 1923, to April, 1926, the defendant-appellee “continued to participate in the defense of said suit.”

It was the defendant-appellee that was the manufacturer of the “Model 16” traps involved in the contempt proceedings; it defending said proceedings.

Notwithstanding these admitted facts, and the solemn admissions of the pleadings, defendant-appellee says:

“The only ‘participation’ of defendant corporation, if it can be possibly designated as such, consisted of assuming and paying, as consideration for

the transfer of the business to it, certain of Lorraine's individual expenses in connection with the suit, long after the case had been tried, decided, appealed, briefed, argued, and submitted for the decision of this Court of Appeals." (Br., p. 20.)

and reiterates:

"There is nothing remotely resembling privity between Lorraine and the Lorraine Corporation relating to the subject-matter of the adjudication in the suit against Lorraine individually, as there was no transfer by Lorraine individually to the corporate defendant of even a single trap which had been held to constitute an infringement upon the Trumble patent in suit." (Br., p. 25.)

Defendant-appellee contents itself with these inconsistent statements and misrepresentations of the facts. It is significant that defendant-appellee does not question (and it cannot successfully) the established rule of law that defendant-appellee having purchased May 1, 1923, *pendente lite*, the gas-trap business of Mr. Lorraine, thereby became completely bound by the adjudication. See page 5 of appellants' opening brief. This rule is so well established that we hesitate to cite further decisions applying the rule.

(5) Defendant-appellee misrepresents the facts in regard to three constructions of traps before this court in the original suit. (See the illustrative drawings opposite page 31 of appellee's brief.) All three of these were held by Judge Wolverton to infringe. Is this gross carelessness, or what is appellee's motive and intent?

The same misleading and incorrect endorsement is found at the bottom of the two respective drawings inserted opposite page 32. Judge Wolverton decreed both

to infringe. This court agreed with him as to "Tonner No. 3," but reversed him as to the Lorraine patent construction, so in appellee's brief denominated "Model No. 1." Can it be that this error is mere carelessness, or was it for the purpose of confusing this court? We refer the court to the next to last paragraph of page 59 of *290 Fed. Rep.*, where this court refers to Tonner No. 3 as "apparently designated in the decision of the court below as Model No. 1."

If such errors, such carelessness of facts, such misleading statements are made in material portions of appellee's brief, is there not good ground for this court's dealing cautiously with all assertions and contentions advanced by appellee and checking each carefully before relying thereon?

(6) Defendant-appellee now contends, as it did in the original case (see this court's opinion, *290 Fed. Rep.*, last paragraph, p. 55) that the Trumble invention must be limited to a combination "where the *whole* body of crude oil is spread *equally* in a *thin film* upon the conical spreader-plates and upon the entire chamber wall intermediate between them and the pool level." This court did not sanction such restriction. (See page 59, next to last paragraph.)

Now in its brief defendant-appellee asserts to Your Honors that:

"All the oil is also spread in Model No. 2 with the nipple machined off, one of the devices found not to be infringed by this court." (Br., bottom p. 33.)

Why does defendant-appellee misstate the facts?

This court in its previous decision adopted the defendant's assertions of its brief in the original case, where under the caption, "Defendant's Model 2 does not infringe," on page 90, defendant says:

"It would seem obvious that the oil coming through the inlet opening 4 *must* in large part fall to the bottom of the separator without striking the walls at all. Indeed, the trial court distinctly so found, stating (near the top of page 538 of the transcript of record) that part of the oil descends 'by gravity *without reaching either wall.*'" (Italics defendant's.)

See further appellants' opening brief herein, p. 16.

(7) Opposite page 43 of appellee's brief there has been produced by appellee an alleged drawing of the type of trap here involved as infringement. This is not a reproduction of any drawing-exhibit to the affidavit of William McGraw. It is a purely argumentative drawing composed by appellee and imprinted with legendary matter unsupported by the physical exhibits A-5 and A-6. We ask Your Honors to carefully inspect these two physical exhibits before relying upon this drawing or its legends as they appear in appellee's brief.

(8) Repeatedly appellee makes the assertion that there was only one trap of the Tonner No. 3 construction made. It is true that in the hearing before Judge Wolverton only one was proven. That was sufficient for determination of the issue of infringement. On the accounting we had the evidence to prove others. This is another illustration of the erroneous character

of appellee's contention that our present showing is not sufficient to require injunctive relief. Appellants require an injunction to prevent further construction and the process of the court on accounting to discover and prove the number, etc., of infringing traps heretofore made by defendant-appellee. Appellants cannot otherwise discover this, unless all such traps are removed from use and junked. Then, by chance only, they may be available for appellants' inspection.

(9) Appellee asserts now, as before in the original case, that:

"There is actually no advantage in the Trumble imperforated cones over those of Bray, not to speak of Fisher, Newman, Cooper and others."
(Printed in italics in appellee's brief, p. 41.)

It is passing strange, if there be no advantage in the imperforate spreading surface or cone, that appellee has not adopted a perforated surface having the function and mode of operation of the Bray cones. No liability for infringement could possibly be incurred thereby, if appellee adopted the Bray principle and relation of parts. But appellee's conduct belies its words. Appellee's "Model 16" traps utilized a perforated plate or bottom through which the oil dropped in drops or streamlets. (See appellants' opening brief, p. 17, and the perforations 4 of the fourth drawing of illustration at end of such brief.) Appellee has apparently abandoned such construction.

Appellee thereafter produced the type of trap of Fig. 3 of the McGraw affidavit (the seventh from the left, of appellants' said illustrations). See appellants' opening brief, p. 18. This trap was provided with perforations or holes through which the oil might or could so drop.

Yet, appellee vouchsafes no explanation for abandoning this construction, or any explanation for proceeding to the infringing constructions with imperforate spreading plates.

(10) Appellee misconstrues the decision of this court as to the scope of the Trumble invention.

This court said (290 Fed. at p. 59):

“* * * the claims are to be read only upon apparatus by which substantially the whole body of oil is spread as a film or thin sheet on a backing wall, and is not, in the course of the process of separation, broken up by any means into drops or streamlets;”

As stated in appellants' opening brief, in the infringing types of traps the whole body of oil is spread on the inner surface of the wall of the trap. In this connection we call the court's attention to the physical Exhibits A-5 and A-6 and to the drawing opposite page 21 of appellants' opening brief. Not only is the whole body of oil spread as a film or thin sheet on the inner curved surface of the tank wall as a backing wall, but in these infringing types of traps the bottom of the expansion chamber or enclosed trough is provided with an end baffle 6 which is pitched downwardly and toward such inclined wall and thereby the spreading of the oil on this interior surface of the trap wall, as a backing wall, is positively insured. With this infringing type of trap, the body of oil “is not, in the course of the process of separation, broken up by any means into drops or streamlets.”

What in appellee's brief, p. 42, is termed “the spiral extension,” *i. e.*, the trough, open at the side toward the

circular wall of the trap, forms in actual effect, both as to location and volume, an expansion chamber, and the function of the walls and formation of this trough not only is to reduce the velocity of the incoming oil but to cause all of it to be spread in a thin film onto the inner surface of the tank wall. If the court judges the question of infringement by the three functions attributed in appellee's brief (p. 42) to the Trumble cone, equivalency is demonstrated and infringement proven. Appellee says that the Trumble cone performs three functions:

“(1) It checks the velocity of the incoming oil;”

This is the function of the expansion chamber formed by the said trough.

“(2) it spreads the oil thinly over its own extended surfaces;”

This is also true because of the increase of volumetric capacity. The arrangement is such as to cause, by reason of the spiral shapes or contours, the oil to be spread from the bottom and sides of the trough onto the curved inner surface of the trap-wall.

“(3) it conveys the oil to the wall of the separator, theoretically, at least, equally at all points, thus continuing the film from the apex of the cone to the oil pool.”

Similarly this mechanical means, the trough, by means of its bottom and side-wall in the same sense conveys the oil to the wall of the separator. It there spreads the oil onto that wall. It conveys the film of oil from the beginning of the trough to the time the oil flows down the inner wall into the pool of oil at the bottom. And this trough is

provided with the end baffle 6 which insures that substantially all the oil is spread upon the curved inner surface of the trap-wall down which it will flow in a relatively thin film into the oil-pool below.

We find, therefore, that the particular several mechanical means which this Court has adjudged in its previous decision to constitute the Trumble invention are utilized in the infringing traps, and these means in such infringing traps are so combined that they perform substantially the same function in substantially the same manner. Equivalency is absolutely present and proven. We respectfully refer this Court to the conclusion of this Court in its former opinion. Having found what is the invention, there need be no difficulty in determining what is the equivalent. This is made clear by the Supreme Court of the United States in its recent decision in *Sanitary Refrigerator Co. v. Winters et al.* (decided October 14th, 1929). In this case the Court reversed the decree and held the patent infringed. The Supreme Court adjudged the invention to be a narrow one. It said:

“Although the claims of the Winters and Crampton patent are limited to the structure therein disclosed, we find that they are infringed by the device of the Dent latch. Both Circuit Courts of Appeals recognized that the Winters and Crampton patent, although thus limited, had some range of equivalents; and we think that, though it be a narrow one, it is sufficient.

“There is a substantial identity, constituting infringement, where a device is a copy of the thing described by the patentee, ‘either without variation, or with such variations as are consistent with its being in substance the same thing.’ *Burr v. Duryee*, 1 Wall. 531, 573. Except where form is of the essence of the invention, it has little weight in the decision of such an issue; and, generally speaking, one device is

an infringement of another 'if it performs substantially the same function in substantially the same way to obtain the same result . . . Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish the same result, they are the same, even though they differ in name, form or shape.' *Machine Co. v. Murphy*, 97 U. S. 120, 125. And see *Elizabeth v Pavement Co.*, 97 U. S. 126, 137. That mere colorable departures from the patented device do not avoid infringement, see *McCormick v. Talcott*, 20 How. 402, 405. A close copy which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement. *Ives v. Hamilton*, 92 U. S. 426, 430. And even where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee and cannot be extended to embrace a new form which is a substantial departure therefrom, it is nevertheless infringed by a device in which there is no substantial departure from the description in the patent, but a mere colorable departure therefrom. Compare *Duff v. Sterling Pump Co.*, 107 U. S. 636, 639.

"The fact that, as the Dent device makes two reciprocal changes in the form of the Winters and Crampton structure, one by the insertion of the lug on the keeper head, and the other in the shortened upper arm of the latch lever, and one alone of these changes cannot be substituted in the Winters and Crampton structure without the other, so as to make it operative, is plainly insufficient to avoid the infringement."

There is nothing substantially new in this decision. It is, however, a perfect example of the application of the law. Having found what is the "invention," the doctrine of equivalents applies to that "invention" whether broad

or narrow. This Court in its previous decision in holding Tonner No. 3 to infringe applied the very rule so applied by the Supreme Court. And so, applying the same rule and the same tests, an adjudication of infringement herein necessarily follows.

The Prior Art Patents.

Should the Court desire to review the prior art patents, it will find that all of these were before this Court in the former case. It will find these discussed in Plaintiffs-Appellees' Opening and Reply Briefs in that case. We shall not therefore discuss each of these patents in detail.

BRAY PATENT No. 1,014,943.

This patent is discussed in the former opinion of this Court. On page 33 of Appellee's Brief it is stated that Trumble's invention "only consists of plugging the holes in Bray's cones." This statement is absolutely incorrect. The cones of the Bray trap came into contact at their peripheries with the inner surface of the wall of the vessel. Therefore, if there were no holes in the Bray cones the oil would remain above the cones and never pass to the bottom of the receptacle. The mode of operation is different and the combinative relations of the several mechanical means or instrumentalities is different.

COOPER PATENT No. 815,407.

In the Cooper patent there is nothing equivalent to the closed trough or runaround baffle-plate of the defendant's infringing devices. In other words, there is no provision for a slowing down and initial separation of the oil and gas prior to the delivery of the mixture onto the wall of

the separator and into the open chamber thereof comparable either to the infringing traps or to the Trumble invention. On the contrary, Cooper discharges the injected mixture of oil and gas directly from the delivery pipe B through an elongated nozzle-shaped opening against a wearing-plate fixed to the inner wall of the cylinder which, undoubtedly, would have a splashing effect due to the delivery of the mixture against the wearing-plate in contradistinction to first quieting down the moving oil in an initial expansion and quieting chamber and spreading it on the wall in a film, as in defendant-appellee's infringing traps, so comparable in this respect to the mechanical means and mode of operation of the Trumble invention. We thus see again the absence in the Cooper device of the mechanical means which this Court adjudged to be of the essence of the Trumble invention and which is reproduced in equivalent form in the infringing traps, Exhibits 5-A and 6-A, or drawings Fig's 5 and 6 of the McGraw Affidavit.

NEWMAN PATENT No. 856,088.

This patent was also an exhibit in the previous case. Appellee's Brief, p. 34, misstates the mode of operation of this device. Therein it is stated that the oil entering through a single pipe has its velocity reduced by being divided by four pipes G1 into four streams, and that

“It then falls in such four streams upon the wedged shaped spreader K1, is deflected to the side walls of the separator down which it flows to the oil pool below.”

The Newman patent is for an improvement in *water* and gas separators. It is stated (at line 10, p. 1) that

the object is to distribute the force of gas especially in high pressure so as to eliminate the spray and give the water a chance to collect and settle at the bottom of the tank. Beginning with line 84, p. 1, the patent states:

“the gas entering the top of the tanks through the pipes G and H, is divided again by the distributors G2, H2, and strikes the hoods K', L' *preventing the gas from boiling up the water accumulated in the bottom of the tank* thus preventing much spray and protects the float M from incoming rush of gas,” etc.

This shows that the hood K' is not designed for, or intended for, the purpose of, or intended to be capable of, spreading the water to the side-walls of the trap in a film. On the contrary, this was designed for interposing an obstruction between the incoming gas at high pressure and the body of water accumulated in the bottom of the tank preventing the jetting of such gas into such water, thereby preventing the gas from having a stirring effect. Also for the purpose of preventing the gas from striking the float when used.

Appellee's modified form of the Newman device, suggested opposite page 35 of appellee's brief, is an attempt, after having knowledge of the Trumble invention and patent, to alter the construction and modify the construction and arrangement of parts shown in the Newman drawing, to make such modified drawing incorporate some semblance of the Trumble invention. But this court will not adjudge the patentable novelty of the Trumble invention by such theoretical modifications and re-arrangements made after and in the light of the Trumble invention, but will apply the rule that a prior patent is only to be considered as anticipatory for that which it actually shows.

What it actually teaches and the mode of operation it teaches is the mode of operation stated in the Newman patent, not a modification made for argumentative purposes.

The illustrative drawing appearing opposite page 35 of appellee's brief is entirely misleading. And the purported comparisons of the Newman and Tonner No. 3 appearing opposite page 36 are misleading, because the walls of the trap in each instance are omitted, and without an illustration of the curved walls of the trap and the functional relation of the illustrated devices to the inner surface of the trap, comparison with the functional relationship of the spreading cone or baffle of the Trumble invention is impossible.

TAYLOR PATENT No. 426,880.

Opposite page 37 of appellee's brief is a purported illustration of a part of the drawings of this patent, and appellee asserts that this drawing "shows the liquid coming into a separator and being immediately spread upon a series of inclined baffle plates in a thin film." What is it that is to be so spread by the Taylor patent? The Taylor patent is for an improvement in Steam Separators. The patent states, beginning with line 13, page 1:

"The object of my invention is to provide a novel apparatus for separating the water of condensation from live steam and eliminating therefrom the particles of grease, oil, or other impurities taken up by the steam in passing from the boiler to the steam-chests of the cylinders."

This statement immediately distinguishes the Taylor patent from the Trumble invention. An entirely different problem is solved by the Trumble invention. This will be

more clearly understood by reference to page 1, beginning with line 72, of the Taylor specification, which describes the operation of Taylor's steam separator :

“As the live steam enters by way of the pipe 3a, it is compelled to flow downward over the surfaces of the baffle-plates 4, whereby any condensations of vapor or particles of oil or grease carried by it are deposited and caused to adhere to said plates, whence the fluid trickles downward and falls into the chamber 8, while the dry and pure steam enters the mouth of the conveyer 6 and passes to the engine.”

This operation is not comparable at all to the Trumble gas-trap. This operation may be compared to blowing one's breath against a pane of glass and the consequent accumulation of moisture on the glass. Clearly, the Taylor patent was not designed for the same purpose, nor does it actually accomplish the same purpose, as the Trumble invention. In the device of the Taylor patent the steam carrying impurities is admitted to the separator and such impurities are separated by the action of blowing the steam against the inclined surfaces. But there is no filming of substantially the whole body of oil on the wall of a gas-trap for the purpose of extending the body of oil and permitting the entrained gas to escape therefrom. It is hard to conceive that the Taylor patent can be adjudged to be in an analogous art.

With respect to this prior art, appellants respectfully submit that there is nothing in it to change the conclusion of this Court as expressed on page 59 of 290 Fed. Rep. Comparing either or both the mechanical construction and interrelation of parts and functions of the Tonner No. 3 trap or the trap of the Trumble patent with defendant-appellee's infringing traps illustrated in Ex-

hibits 5-A and 6-A or Figs. 5 and 6 of the drawings attached to the McGraw affidavit, it is clear that the combination of elements, the functions and mode of operation are the same. Defendant-appellee's infringing traps have, by the mechanical means of the enclosed trough or run-around baffle open at its side adjacent the trap wall whereby the oil is filmed on the interior curved surface of the trap wall, adopted the full equivalent of the Tonner No. 3 baffle or Trumble spreading cone. The walls of said enclosed trough or runaround baffle are the mechanical means causing the spreading of the oil onto the interior curved trap wall surface, and the provision at the end of this trough or runaround baffle of the inclined separator plate or baffle 6 certainly completes full equivalence in the same sense, both as to mechanical construction or means and as to functional relation, as did the baffle-plate of Tonner No. 3 so referred to by this court in its opinion.

Thus, as to mechanical means, as well as cooperative function, the infringing traps differ from the prior patented art relied upon by appellee in the same respects as do the spreading means, *i.e.*, spreading cone of the Trumble patent and the baffle of Tonner No. 3.

Appellants respectfully submit that the lower court erred in its interpretation of the scope of the Trumble invention. That the lower court erred in its interpretation of the decision of this Court. And that the order appealed from should be reversed.

In closing, it seems fitting to urge to Your Honors an outstanding fact which should be given due weight. Notwithstanding that defendant in the original case belittled the importance of the Trumble invention and sought to

impress this Court with that view, the fact remains that seven years later, and while the Trumble invention has had an important place in this art for sixteen years, defendant-appellee, although free to use many other trap constructions, is forced to pirate this limited invention. This conclusively demonstrates the importance of the Trumble invention. Throughout all these years the Trumble invention has maintained its beneficial place in the practical art. It has neither been abandoned nor superceded. It is such inventions, so tested out, that should and do recommend themselves to the courts for protection. As said by Judge Coxe in *Hallock v. Davison*, 107 Fed. 482, 486:

“If there be one central, controlling purpose deducible from all these decisions, and many more that might be quoted, it is the steadfast determination of the court to protect and reward the man who has done something which has actually advanced the condition of mankind, something by which the work of the world is done better and more expeditiously than it was before.”

Respectfully submitted,

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